

Application Serial No 10/006,733
In reply to Office Action of 28 July 2006

Attorney Docket No 83042

REMARKS / ARGUMENTS

Claims 1-18 are currently pending in the application. No claims have been allowed. Claims 1-18 are rejected. Claims 1-3 and 11 have been amended by this response. Claim 10 has been canceled without prejudice

The Examiner has rejected claims 1-18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirements.

The Examiner has rejected claims 1-18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner rejected claims 1-9 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Maxwell (reference B: U.S. Patent No. 6,195,643).

The Examiner rejected claims 10-15 under 35 U.S.C. § 103(a) as being unpatentable over Maxwell in view of Karszes (reference u: Jason Karszes & Wayne Knoblauch, "Five Points help evaluate new technology.")

These rejections are respectfully traversed in view of these amendments and remarks that follow.

Applicants have amended the specification to provide more detail concerning the calculation of an opportunity value and an idea value. This detail does not constitute new matter because

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it is in claims 3 and 4 and the drawings but not discussed in the specification.

Applicants have amended claim 1 to include a step for identifying core equities of an organization. The step of filtering is amended to filter the collected idea data by reference to the identified core equities. This is a clearer claiming of Applicants' method. These amendments are supported in the specification at page 11, lines 6-8.

Applicants have amended claim 2 to better define the process for filtering formal announcements. Claims 3 and 11 have been amended to place them in independent form by incorporating all limitations from the parent claim and, in the case of claim 11, intervening claim 10. Claim 10 has been canceled without prejudice.

Concerning the Examiner's rejection of claims 1-18 under 35 U.S.C. § 112, Applicants request that the Examiner specifically identify any steps of the invention that are not enabled. It is suggested that every step of this method is fully supported in the specification in such terms that one of ordinary skill in the art could use the invention. Specifically, Applicants' step of collecting ideas is supported at page 10, lines 12-16 of the specification. Applicants' step of filtering is supported at page 10, line 24 through page 12, line 8. Opportunity analysis is discussed on page 12, line 9 through page 22, line 10.

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Extensive detail is provided concerning this step in order to make it more reproducible and less subjective. Committing resources is discussed on page 22, line 11 through page 26, line 21. The step of writing a business proposal is supported on page 28, line 5 through page 29, line 15. The step of submitting the proposal to the buyer is given on page 29, lines 16-25. The step of determining success is given on page 30, lines 1-9; and the step of executing the business plans is given on page 30, lines 10-14. These steps were clearly identified in the specification and fully discussed in such terms that they could be executed by one of ordinary skill in the art.

Identification of specification support for claims 2-18 can be provided if necessary to address a specific rejection.

Accordingly, it is requested that the Examiner specifically identify which claims or elements fail to enable the invention rather than issuing a blanket rejection of claims 1-18.

Applicants suggest that just because the steps of a method require subjective decision making, this does not render them not enabled. Subjectivity is controlled in decision making processes by aggregating the subjective opinions to filter out those opinions that are outside of mainstream reasoning. Subjectivity is also controlled by establishing metrics and criteria. Applicants suggest that gathering subjective opinions in a fully systematized manner does not constitute "undue

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experimentation." Reconsideration and withdrawal of this rejection is respectfully solicited.

In view of the Examiner's statutory subject matter rejection, Applicants respectfully request that the Examiner make explicit findings concerning the rejection of claims 1-18 as non-statutory subject matter. The Examiner's rejections merely consist of a bare statement that because the invention has steps requiring subjective decisions, the invention is not patentable. This clearly goes against the Examiner's own statement that "the mere fact that the result is an estimate, prediction or other approximation that may not ultimately be found to be accurate is not a determinative factor for concreteness." (emphasis added).

Applicants invention provides a systematized business development process. This is a "process" under the statutory subject matter categories given by § 101. Applicants suggest that the claimed process is "useful, concrete and tangible" and meets the requirements of *State Street Bank & Trust v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The process provides a business opportunity for development that has been analyzed as the most favorable opportunity, has been developed as a proposal, has appropriate resources committed, and has been accepted by a buyer. Applicants suggest that the business opportunity for performance

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is a useful result because it gives direction to the practicing business entity.

The specification of the invention has steps that are well defined to one of ordinary skill in the art, so that these steps will create a uniform result. The business opportunity for performance is forced to be more concrete by the development process. If one of ordinary skill in the art executes the steps disclosed in the specification on a plurality of business opportunities, they would most likely identify the same business opportunities as being valid. This is within the requirements that "a claim directed to estimating, predicting or approximating something does not necessarily lack concreteness."

This invention meets the tangible result requirement because execution of the business opportunity is a real world result. Out of the plurality of business opportunities, one business opportunity is executed. Execution of this business opportunity involves labor, transfer of resources and transfer of information. These are elements of a real world result.

Applicants further suggest that this method is not a law of nature, a natural phenomenon, or an abstract idea. As such, Applicants' process clearly falls within the statutory subject matter given by §101. Applicants respectfully request reconsideration and allowance of these claims.

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Concerning the Examiner's rejection of claims 1-9 and 16-18, Applicants suggest that Maxwell is not wholly applicable to the matter taught by the Applicants. Maxwell is a system for evaluating the suitability of software applications to a situation. Software applications are a commercial item having known quantities and costs. Applicants suggest that by using a hindsight analysis from Applicants disclosure, the Examiner is reading elements into Maxwell that are not clearly present. Applicants suggest that the Examiner has analogized a software purchase decision to the entrepreneurial decision to engage in a business opportunity that may involve labor, skills, production, marketing and management. In view of the extensive differences between the scope of the decision, Maxwell is not clearly applicable.

More specifically, Maxwell does not teach the same steps of filtering as Applicants' amended claims 1, 3 and 10. Maxwell teaches filtering of a product demand against an available product whereas Applicant teaches identifying organizational core equities and filtering a business opportunity against those core equities. This process is different because Maxwell establishes a need for the filter criteria, and Applicants' establish an organizational characteristic for the filter criteria. One can easily change a need criteria but changing an organizational characteristic is very difficult. Applicants

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suggest that this distinction in the filtering process is sufficient to make claims 1-18 non-obvious to one of ordinary skill in the art. Reconsideration and allowance of these claims is respectfully requested.

Specifically concerning the Examiner's rejection of claim 3, as amended, Applicants suggest that the process for grading strengths and weaknesses of the identified business opportunity is neither taught nor made obvious by Maxwell. The step of grading strengths and weaknesses cannot be rendered obvious by Maxwell because Maxwell concerns a simple purchase decision. One of ordinary skill in the art would not consider the market, economics, competitive advantage, the team, and potential flaws when one is merely purchasing software. Applicants respectfully request that the Examiner identify prior art providing a showing of Applicants' steps of grading strengths and weaknesses, entering project identifying information, automatically summarizing, archiving opportunities, and forwarding identified potential business opportunities. Applicants suggest that claim 3 as amended should be allowable over Maxwell. Claims 4-9 should be allowable by dependency.

Concerning claims 5-9, Applicant requests that the Examiner provide his basis for concluding that these limitations are obvious. Absent such a basis, it is suggested that the Examiner has not made a *prima facie* case of obviousness, and the claims

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must be allowed. Claims 5-9 act to limit the step of grading claimed in claim 3. It appears to the Applicant that, since the Examiner found that the step of grading was obvious without supporting prior art, his findings regarding these claims are even weaker. Reconsideration and allowance of these claims is requested should the Examiner be unable to provide such basis in the prior art.

Concerning the rejection of claims 16-17, Applicants suggest that completing a modular proposal process is "not capable of instant and unquestionable demonstration as being well known" under the requirements of MPEP 2144.03. FIG. 32 and page 28, line 16 through page 29, line 15 of Applicants specification have significant detail concerning this step. Applicants suggest that such a modular proposal is not well known. The Examiner is requested to support his assertion of Official Notice or withdraw these rejections.

Concerning the Examiner's rejection of claims 10-15, Applicants have canceled claim 10 and amended claim 11 to place it in independent form while including the limitations of claims 1 and 10. Applicants respectfully suggest that, contrary to the findings of the Examiner, Karszes does not teach risk benchmarks, risk criteria, reward benchmarks or reward criteria. A benchmark is defined by Webster's Ninth New Collegiate Dictionary (1990) in definition 2. a. as "a point of reference

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from which measurements may be made" and in definition 2. b. as "something that serves as a standard by which others may be measured or judged". The underlying thread of all these definitions is that the benchmark must be a defined value. Applicants give these defined values on FIG. 9 and in Table 2 on page 20. Karszes merely has a list of considerations that do not rise to the level of being standards. In view of this, Applicants suggest that Karszes does not teach nor make obvious Applicant's step "developing risk benchmark values" or "developing reward benchmark values". Applicants respectfully request reconsideration and allowance of claims 10-15.

In view of the Remarks above, the Applicants respectfully request reconsideration and allowance of the application.

The Examiner is invited to telephone James M. Kasischke, Attorney for Applicants, at 401-832-4736 if, in the opinion of the Examiner, such a telephone call would serve to expedite the prosecution of the subject patent application.

Respectfully submitted,
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30 October 2006

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